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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,089	02/07/2006	Sawako Nakamura	58922US005	2391
32692 7590 02/12/2008 3M INNOVATIVE PROPERTIES COMPANY PO BOX 33427 ST. PAUL, MN 55133-3427				
EXAMINER DESAL, ANISH P				
ART UNIT 1794		PAPER NUMBER		
NOTIFICATION DATE 02/12/2008		DELIVERY MODE ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

LegalUSDocketing@mmm.com  
LegalDocketing@mmm.com

### Office Action Summary

**Application No.**

10/595,089

**Applicant(s)**

NAKAMURA, SAWAKO

**Examiner**

ANISH DESAI

**Art Unit**

1794

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 11-28 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. This application contains claims directed to the following patentably distinct species. The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. The adhesive tapes of each independent claim encompass distinct adhesive composition, and distinct arrangement of the adhesive layers wherein each adhesive layer has distinct adhesive composition. For example, a pressure sensitive adhesive layer of claim 11 includes acrylic polymer that is formed by copolymerizing nitrogen-containing monomer and carboxyl group containing monomer with alkyl(meth)acrylate monomer and the adhesive further contains a metal hydrate, whereas the pressure sensitive adhesive layer (e.g. first PSA layer) of claim 12 includes acrylic polymer that is formed by nitrogen-containing monomer copolymerized with the alkyl (meth)acrylate containing monomer, and the adhesive further includes a metal hydrate. In addition, these species are not obvious variants of each other based on the current record. Thus, Applicant is requested to elect a single pressure-sensitive adhesive tape from the following:

(A) A halogen free flame-retardant acrylic pressure-sensitive adhesive sheet or tape comprising...a pressure-sensitive adhesive having an acrylic polymer containing units derived from...alkyl(meth)acrylate...nitrogen containing monomer...carboxyl group containing monomer...wherein the nitrogen-containing monomer and the carboxyl group-containing monomer are copolymerized with the alkyl(meth)acrylate monomer...the adhesive is disposed upon said base material.

(B) A flame-retardant acrylic pressure-sensitive adhesive tape or sheet comprising...a halogen-free flame retardant-containing first pressure-sensitive adhesive layer....first acrylic polymer containing units derived from a first mixture comprising...alkyl(meth)acrylate monomer...nitrogen-containing monomer, and...a metal hydrate compound...wherein the nitrogen containing monomer in the first mixture is copolymerized with the alkyl(meth)acrylate monomer in the first mixture wherein...first pressure-sensitive adhesive layer is disposed upon said base material; and a second pressure-sensitive adhesive layer...second mixture comprising...alkyl (meth)acrylate monomer and...carboxyl group-containing monomer wherein the carboxyl group containing monomer in the second mixture is copolymerized with the alkyl (meth)acrylate monomer in the second mixture.

(C) A flame-retardant acrylic pressure-sensitive adhesive tape or sheet comprising...a first pressure-sensitive adhesive layer...containing a first acrylic polymer containing units derived from a first mixture comprising...alkyl(meth)acrylate monomer and a carboxyl group containing monomer...a metal hydrate compound...wherein the carboxyl group-containing monomer in the second mixture is copolymerized with the alkyl(meth)acrylate monomer in the second mixture, and a second pressure-sensitive adhesive layer in contact with...containing an acrylic polymer containing units derived from a second mixture comprising...an alkyl(meth)acrylate monomer...a nitrogen containing monomer...wherein the nitrogen-containing monomer in the second mixture is copolymerized with the alkyl(meth)acrylate monomer in the second mixture.

2. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there are no generic claims.
3. There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.
4. **Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined** even though the requirement may be traversed (37 CFR 1.143) **and (ii) identification of the claims encompassing the elected species**, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
5. The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

6. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

7. Due to the complexity involved in the restriction requirement, a telephone call was not made to Applicant's attorney/agent to request an oral election to the above restriction requirement.

8. Once Applicant elects one of the species from above, Applicant's arguments received on 11/08/07 will be addressed in the subsequent Office Action.

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANISH DESAI whose telephone number is (571)272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1794

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. D./

Examiner, Art Unit 1794

APD

/Terrel Morris/

Terrel Morris

Supervisory Patent Examiner

Group Art Unit 1794